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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,564	12/18/2001	Jyrki Hoisko	413-010737-US(PAR)	2681
2512	7590	02/10/2005	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			NGUYEN, DAVID Q	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,564

Applicant(s)

HOISKO ET AL.

Examiner

David Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 6,070,053).

Regarding claim 1, Yamashita discloses a method for the caller and/or called party to the conversation partner in communication by telephone (see abstract), where the caller and called party send each other messages during the communication (see col. 4, lines 29-47 and col. 5, lines 1-15), the recipient of a message hears a musical composition of the sender of the message (see col. 4, lines 29-47 and col. 5, lines 1-15). Yamashita discloses the musical composition being any desired music (see col. 3, lines 15-21) instead of the musical composition representing the affective state of the sender of the message. Examiner takes Official Notice of equivalence of the Yamashita's the musical composition equivalents to the musical composition representing the affective state of the applicants so that the called party knows sender's expressing.

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3. Claims 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 6,070,053) in view of Goldberg et al. (US 6125175).

Regarding claim 2, Yamashita does not disclose wherein the message of caller and called party are speech messages. However, Goldberg et al. discloses the message of caller and called party are speech messages (see col. 1, line 54 to col. 2, line 5; col. 3, lines 9-11 and abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goldberg et al. to the method of Yamashita in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

4. Claims 3-4,6-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 6,070,053) in view of Cardina et al (US 6151500).

Regarding claim 3, the method of Yamashita does discloses the system comprising at least one phone is a cellular phone (see col. 4, lines 29-47 and col. 5, lines 1-15) except for wherein the communication takes place in a system comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone. However, Cardina et al discloses a system for sending message between caller and called party comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone (see fig. 1 and abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Cardina et al to the method of Yamashita in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Regarding claim 4, the method of Yamashita in view of Cardina et al also discloses wherein the phone of the caller is a cellular phone (see col. 4, lines 29-47 and col. 5, lines 1-15 Yamashita); and the musical composition is attached to the message sent by the caller (see col. 4, lines 29-47 and col. 5, lines 1-15 of Yamashita).

Regarding claim 6, the method of Yamashita in view of in view of Cardina et al discloses wherein the phone of the called party is a cellular phone (see col. 4, lines 29-47 and col. 5, lines 1-15 of Yamashita); and the musical composition is attached to the message sent by the caller (see col. 4, lines 29-47 and col. 5, lines 1-15 of Yamashita).

Regarding claims 7-9, the method of Yamashita in view of in view of Cardina et al also discloses there is transferred from the caller to the called party an identifier on the basis of which the musical composition is selected (see col. 4, lines 29-47 and col. 5, lines 1-15 of Yamashita); wherein the identifier specifies the name of the musical composition (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita); wherein the identifier specifies the affective state of the caller (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita); wherein the phone of the called party and caller are cellular phones (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

Regarding claim 10, the method of Yamashita in view of in view of Cardina et al discloses the musical composition is attached to the message sent by the caller in the equipment of the operator switching the call (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

Regarding claims 11-13, the method of Yamashita in view of in view of Cardina et al also discloses wherein there is transferred from the cellular phone of the caller to the operator an identifier on the basis of which the musical composition is selected; wherein the identifier

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specifies the name of the musical composition; wherein the identifier specifies the affective state of the caller (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

Regarding claim 14, the method of Yamashita in view of in view of Cardina et al also discloses wherein the phones of the caller and called party are cellular phones (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita); and from the caller to the called party there is sent a file which contains a musical composition stored in electric form (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

Regarding claim 15, the method of Yamashita in view of in view of Cardina et al also discloses that wherein the musical composition is set to be played on the cellular phone of the called party (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

Regarding claim 16, the method of Yamashita in view of in view of Cardina et al also discloses that wherein the musical composition is set to be played on a separate sound reproducing apparatus connected to the cellular phone of the called party (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

Regarding claim 17, Yamashita disclose a system for for expressing an affective state of a caller and/or called party to the conversation partner in communication by telephone, where the caller and called party send each other messages (see explanation in claim 1); wherein the system further comprises a directory storing musical compositions representing various affective states and a menu for selecting musical compositions in the directory (see col. 4, lines 29-47 and col. 5, lines 1-40); the system comprises at least one cellular phone (see col. 4, lines 29-47 and col. 5, lines 1-40). Yamashita does not mention the system comprises the equipment of an operator switching calls. However, Cardina et al discloses a system for sending message between caller

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and called party comprising equipment of an operator switching calls (see fig. 1 and abstract). It is apparent that the system of Cardina et al combined with the system of Yamashita would suggest or disclose the system comprises at least one cellular phone and the equipment of an operator switching calls.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Cardina et al to the method of Yamashita in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Regarding claim 18, the system of Yamashita in view of Cardina et al also discloses wherein the musical compositions are stored in the directory in electric form (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

Regarding claim 19, the system of Yamashita in view of Cardina et al also discloses does not mention wherein the musical compositions are stored in the directory in the form of midi or mp3 files. Official notice taken that the musical compositions are stored in the directory in the form of midi or mp3 files is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the system of Yamashita in view of Cardina et al so that the caller/called party can listen to music in many different formats.

Regarding claims 20-21, the system of Yamashita in view of Cardina et al also discloses wherein the directory is in the cellular phone of the caller (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita); wherein the directory is in the cellular phone of the called party (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

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Regarding claim 23, the system of Yamashita in view of Cardina et al also discloses wherein the menu is arranged to be at least in the cellular phone of the caller (see col. 4, lines 29-47 and col. 5, lines 1-40 of Yamashita).

5. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (US 6,070,053) in view of Cardina et al (US 6151500) and further in view of Goldberg et al. (US 6125175).

Regarding claim 5, the method of Yamashita in view of Cardina et al does not disclose wherein the musical composition is transferred together with the message on the same audio channel from the cellular phone of the caller to the phone of the called party. However, Goldberg et al. disclose wherein the musical composition is transferred together with the message on the same audio channel from the cellular phone of the caller to the phone of the called party (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goldberg et al. to the method of Yamashita in view of Cardina et al in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Regarding claim 22, the system of Yamashita in view of Cardina et al does not discloses wherein the directory is in the equipment of the operator. However, Goldberg et al. discloses wherein the directory is in the equipment of the operator (see col. 2, lines 44-54 of Goldberg et al). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goldberg et al. to the method of Yamashita

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in view of Cardina et al in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 703-605-4254. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moise Emmanuel can be reached on 703-306-0003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN
David Nguyen

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